

RD



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,952	10/26/2001	Mark H. Tuszynski	041673-2054	7826
30542	7590	04/02/2004	EXAMINER	
FOLEY & LARDNER			CHEN, SHIN LIN	
P.O. BOX 80278			ART UNIT	
SAN DIEGO, CA 92138-0278			PAPER NUMBER	
			1632	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/032,952	<b>Applicant(s)</b> TUSZYNSKI, MARK H.	
	<b>Examiner</b> Shin-Lin Chen	<b>Art Unit</b> 1632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10-2-03, 11-3-03 and 12-31-03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-31-03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's amendments filed 11-3-03 and 12-31-03 and declarations by Dr. Mark Tuszynski filed 10-2-03 and 12-31-03 have been entered. Claims 1, 4, 5 and 7 have been amended. Claims 13-20 have been added. Claims 1-20 are pending and under consideration.

#### ***Priority***

In the priority paragraph on page 5 of the amendment filed 11-3-03, the issued US Patent No. for Application No. 09/060,543 should be **6,451,306** not 6,167,888. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's amendments filed 11-3-03 and 12-31-03 necessitate this new ground of rejection.

The term "proximity" in line 5 of claim 1 is vague and renders the claim indefinite. It is unclear as to the metes and bounds of what would be considered "within proximity to a targeted cell". The specification fails to specifically define the term "proximity". One of ordinary skill in

Art Unit: 1632

the art can interpret the phrase “within proximity to a targeted cell” differently, for example, a few mm from the targeted cells or a few cm from the targeted cells.

Applicant cites references Conner et al., Curtis et al., von Bartheld et al., Ebendal, and Sariola et al., and argues that the expressed neurotrophin can be transported in a retrograde direction or in an anterograde direction, or via intracellular transport and one of ordinary skill would know the meaning of “proximity” (amendment filed 12-31-04, p. 5-7). This is not found persuasive because of the reasons set forth above and that although expressed neurotrophin can be transported in a retrograde direction or in an anterograde direction, or via intracellular transport within the brain, different neurotrophin of different protein sizes can travel differently, such as different mechanisms and different distances, within the brain either at the same brain region or at different region. The distance range from the targeted cells is not specifically defined regarding the term “proximity”. It is unclear how far away from the targeted cells is considered “proximity” and one of ordinary skill in the art can interpret the term “proximity” differently.

Applicant cites the common definition of “proximity” from Webster’s Dictionary and argues that absent an alternative meaning imparted by the written disclosure, terms in a patent claim are given their plain, ordinary, and accustomed meaning to one of ordinary skill in the art (amendment filed 12-31-03, p. 7-8). This is not found persuasive because of the reasons set forth above and that Webster’s Dictionary fails to specifically define the term “proximity” and one of ordinary skill in the art still does not know how far away from the targeted cells is considered “proximity” and can interpret the term “proximity” differently.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4-7, 11 and 12 remain rejected and claims 14 and 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8, 11, 12 and 17 of U.S. Patent No. 6,683,058 (Application No. 09/620,174).

Although the conflicting claims are not identical, they are not patentably distinct from each other because although drawn to different scope, they encompass the same invention and obvious variants thereof.

Applicant's indication in the amendment filed 11-3-03 (page 6) of submitting a terminal disclaimer as required on patenting of the claims of the '174 application (Patent No. 6,683,058) is acknowledged.

It should be noted that Application No. 09/620,174 is now issued patent 6,683,058, thus, the double patenting rejection is no longer provisional rejection. The newly added claims 14 and 17-20 are obvious over the claims of patent No. 6,683,058.

***Conclusion***

No claim is allowed.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (571) 272-0726. The examiner can normally be reached on Monday to Friday from 9:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for this group is (703) 872-9306.

Application/Control Number: 10/032,952

Page 5

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Shin-Lin Chen, Ph.D.

A handwritten signature in black ink, appearing to read "Shin-Lin Chen", written in a cursive style.